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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,158	11/28/2001	Todd Samstrom	6740-519	2115

32300 7590 11/18/2003

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EXAMINER

CRENSHAW, MARVIN P

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 11/18/2003

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/996,158
Filing Date: November 28, 2001
Appellant(s): SARNSTROM, TODD

George E. Helget
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 23, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1,2,7 and 12 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Claim 11 Stands alone.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,987,448	Chikama	01-1991
4,959,910	Hamilton	10-1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2, 7 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chikama.

Chikama teaches a register cam (Fig. 2) for use in a printing press comprising a body (15) and at least two cam arms (11 B and 11 C) extending outwardly from the body. With respect to claim 2, a register cam (11) having at least two cam arms movably connected (Fig. 2) to the body to permit the at least two cam arms to be locked in one of a first position and a second position relative to the body. With respect to claim 7, a register cam having a first cam arm (11 B) extending from the body, a second cam arm (11 C) extending from the body and a means (16) for positioning the first cam arm and the second cam arm relative to the body. With respect to claim 12, a register cam (Fig. 2) for use on a printing press comprising a body and at least one cam arm extending from the body, the at least one cam arm (11 B) including a first face and a

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second face, the first face having a first profile and the second cam (11 C) having a second profile and the at least one cam secured to the body to permit the arm to be rotated (See Fig. 4a, the cam is showed moving) between at least a first position and a second position.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton. Hamilton teaches a register cam (Fig. 2A) for a printing press comprising at least a first face (front side of 14) and a second face (back side of 14) with said first face having a first profile and the second face having a second profile. The structure is suitable to reject claim 11, since the language concerning the faces being "selectable" does not set forth any structure and is hence not sufficient to patentably distinguish the claimed invention from the prior art.

(11) *Response to Argument*

Claims 1,2,7 and 12 are properly rejected under 35 U.S.C. 102(b) as being anticipated by Chikama.

On page 3 of the Brief, Appellant argues that "Nowhere does the '448 patent teach or suggest a registration cam as described and claimed by Appellant". Also, throughout the Brief Appellant argues that Chikama does not teach elements of the invention as described in the specification. These arguments are not sufficient to overcome the 102(b) rejection of the claims, since it does not address what claimed structure Appellant believes defines over the Chikama patent. The examiner acknowledges that the device taught by Chikama is different from the device described

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by Appellant in the specification, however it is the examiner's position that claims 1,2,7 and 12 are anticipated by Chikama.

Appellant attempts to distinguish the claimed invention from the prior art by pointing out that Chikama relates to a skew detection mechanism as opposed to a registration cam for a printing press. Appellant supports this argument by stating that "the claimed registration cam translates the motion of the gripper bar to selectively position a cut sheet of paper on a printing press". However, this argument is not sufficient to distinguish the claimed invention from the prior art since the argument is more specific than the claims. The structure claimed in claim 1 (claims 1,2,7 and 12 stand or fall together) includes only a "body" and "at least two cam arms extending outwardly from the body". The only mention of a printing press in the claim is the preamble, which is "A register cam for use on a printing press". This preamble merely states the intended use of the invention, and the body of the claim fully sets forth all of the limitations of the claimed invention. Therefore, the preamble is not sufficient to patentably distinguish the claimed invention from the prior art, and the patentability of the claim must be determined by comparing the prior art to the structure set forth in the body of the claim.

As stated above, the structure in the body of claim 1 includes only a "body" and "at least two cam arms extending outwardly from the body". This structure is met by Chikama which teaches a body (15) and at least two cam arms (11 B and 11 C) extending outwardly from the body. It is moot that Chikama is for a skew detection mechanism as opposed to a registration cam as described in applicant's specification,

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because the structure of the claimed invention is more broad than Appellant's specification, and is anticipated by the body (15) and cam arms (11 B and 11 C) of Chikama.

Appellant has argued that the preamble "A registration cam for a printing press" should be given weight since it is necessary to give life, meaning, and vitality to the body and cam arms of Appellant's claims. The examiner respectfully disagrees with this argument because it is clear that the body of the claims stands alone and defines a complete structure. Contrary to Appellant's arguments, the examiner has not applied a litmus test to the claims to determine whether the preamble should be given weight, but has evaluated the claims as well as the entire contents of the file wrapper to conclude that the preamble is not sufficient to patentability distinguish the claimed invention from the prior art. The body of claim 1 includes only a body and at least two cam arms extending outwardly from the body. This structure is entirely complete on its own and does not require additional features or description for completeness. There is no mention of a printing press nor any discussion of registration. The body of the claim does not refer to the preamble in any manner, and although the Appellant has argued that the preamble is necessary to give life, meaning and vitality to the body, Appellant has not identified how this is so.

The argument by Appellant that it is only by the preamble "that it can be known that the subject matter of the claims is comprised of a registration cam for a printing press" is not sufficient to show how the preamble breathes life and meaning into the body of the claim. That the preamble defined a device "for a printing press" is merely

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an intended use of the claimed structure. Since the skew correction device of Chikama is capable of being used in a printing press (ie. skew correction in a printing press), it meets the intended use of Appellant's claims.

Claims 11 is properly rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton.

Appellant disagrees with the examiner's position that the term "selectable" as used in claim 11 does not set forth any structure. Appellant argues that the "selectable" limitation "fairly conveys the novel capabilities of Appellant's invention to a person of ordinary skill in the art as used in the claim and as set forth in the specification and figures". This statement, however, does not state what structure the term "selectable" sets forth. The claim does not define how the faces are selectable nor what it means to say that the faces are selectable. The claim does not include any language addressing structure that selects either of the faces. Accordingly, the term "selectable" is not sufficient to patentably distinguish the claimed invention from Hamilton because this term does not impart any structural limitations to the claims.

Appellant has also argued that the examiner has not evaluated and considered the "selectable" limitation. However, this is not so. The "selectable" limitation has been considered, as discussed in the immediately preceding paragraph, and since there is nothing in this limitation to define the term "selectable" and impart a structural limitation into the claim, it has been determined that the "selectable" limitation is not sufficient to patentably distinguish the claimed invention from Hamilton.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

MPC

November 14, 2003

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